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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,675	01/26/2000	David L. Multer	FUSN1-01001US0	8895

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VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 MARKET STREET, SUITE 540  
SAN FRANCISCO, CA 94105

EXAMINER

ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/491,675

Applicant(s)

MULTER, DAVID L.

Examiner

Mohammad Ali

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5-9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This communication is responsive to the application filed on January 26, 2000.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-48 are drawn to a data transmission system includes a differencing transmitter transmitting with at least one set of difference transactions and differencing receiver receiving said at least one set of difference transactions and the data transmission source is coupled to a network, classified in class 709, subclass 248.
- II. Claims 49-75 are drawn to a data synchronization system for a first file and second file resident on a first and second systems and the resulting from changes to a first file on the first system and second file on the second system, classified in class 707, subclass 201.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention in Group I has separate utility such as data transmission includes differencing transmitter transmitting with at least one set of difference transactions and differencing receiver receiving said at least one set of difference transactions and the data transmission source is coupled to a network. See MPEP § 806.05(d). Invention in Group II has separate utility and a data synchronization system for a first file and second file resident on a first and second

systems and the resulting from changes to a first file on the first system and second file on the second system.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

During a telephone conversation with Mr. Larry Vierra (Reg. No. 33,809) on April 23, 2003 a provisional election was made **without traverse** to prosecute the invention of a data synchronization system result change in a file, claims 49-75. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants are advised that the reply to this requirement to be complete must include and election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

3. Applicant is reminded of the proper language and format for an **abstract** of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. Claims 1-75 are pending in this Office Action. Claims 49-75 are presented for examination.

***Information Disclosure Statement***

5. The references cited in the IDS, PTO-1449, Paper Nos. 3, 5-9 have been considered.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 49-60, 66-67, and 71-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodnar et al ('Bodnar'), US Patent 6,295,541 B1.

As to claim 49, Bodnar discloses a data synchronization system for a first system (desktop computer) having a plurality of data sources each with a data source format, and a second system (hand-held device) having a plurality of data sources each with a data source format (Abstract, lines 1-16, col. 4, lines 18-19, Fig. 2,). Bodnar teaches 'a first data synchronizer on the first system transmitting at least one set of difference information to an output' as synchronization allows user to specify in particular record files of the same data type in different datasets to each other. For example, the user may specify that a record file named "Business Contacts" in a first dataset, a record file named "Contacts" in a second dataset, and a record file named "Customer List" in a third dataset be mapped to one another (col. 7, lines 40-46 et seq). Finally, Bodnar teaches 'a second data synchronizer on the second system coupled to the first system receiving said at least one set of difference information from the first system' as synchronization system transforms records from one dataset's representation into another dataset's representation and configure the results (col. 8, lines 2-20, Fig. 2 et seq).

As to claim 50, Bodnar teaches 'difference information comprises change transactions from the data source to the data destination' as given the user's specification of participating clients, a goal (destination) of the Synchronizer is to

automatically achieve the requested synchronization result for the user, without requiring further user input (col. 22, lines 20-23).

As to claim 51, Bodnar teaches 'a data source interface' as unified user interface to the user for synchronization and arbitrary number of the user datasets (col. 4, lines 3-5). Further, Bodnar teaches 'a copy of a previous state of each said data source' as the backup/restore panel 508 permits the user to generate a back-up copy of the client's dataset or to select previously generated back-up cop(ies) of the client's dataset for restoration to the client (col. 18, lines 51-54). Bodnar teaches 'a source data constructor applying difference information to said copy' as (col. 36, lines 15-44 et seq). Finally, Bodnar teaches 'a difference information generator' as (col. 23-31 et seq)

As to claim 52, Bodnar teaches 'difference information is transmitted from said first synchronizer to said second synchronizer in a universal format' as (col. 4, lines 15-33 et seq).

As to claim 53, Bodnar teaches 'data synchronizer includes a plurality of difference source interfaces, each corresponding to a data source format' as (col. 4, lines 15-33 et seq).

As to claim 54, Bodnar teaches 'first system and second system are coupled via a network' as (Figs. 2-3A).

As to claim 55, Bodnar teaches 'network is the Internet' as the system transform from an Internet Sidekick.RTM. cardfile for business contacts into a synchronization-system-internal representation (col. 8, lines 3-7).

As to claim 56, Bodnar teaches 'first system is a server and said second system is a device capable of communicating with said server' as (Abstract, lines 1-20 et seq).

As to claim 57, Bodnar teaches 'first and second systems are coupled to a storage server, and said difference information is transmitted to said storage server by said first synchronizer and retrieved from said storage server by said second synchronizer' as (col. 4, lines 15-33 et seq).

As to claim 58, Bodnar teaches 'systems are coupled to said storage server via the Internet' as the system transform from an Internet Sidekick.RTM. cardfile for business contacts into a synchronization-system-internal representation (col. 8, lines 3-7 et seq).

As to claim 59, Bodnar teaches 'a management server communicating with said first and second data synchronizers' as (col. 4, lines 18-33 et seq)

As to claim 60, Bodnar teaches 'management server indicates a location on the storage server where difference information for said synchronizers are stored' as (col. 4, lines 18-25 et seq).

As to claim 66, Bodnar discloses a method for synchronizing at least a first file and a second file resident on a first and a second systems, respectively (col. 4, lines 11-33, Figs. 2-3A et seq). Bodnar teaches 'determining difference data resulting from changes to a first file on the first system' as a unified user interface is provided that allows the user to easily determine which of his or her datasets are currently set to be synchronized and allows the user to conveniently alter the current settings to select one, two, or even more than two clients for synchronization. Various "conflict" or "duplicate"



Art Unit: 2177

resolution strategies are described for intelligently handling complexities resulting from allowing synchronization for an arbitrary number of datasets and allowing synchronization using even data from datasets that are not available (Abstract, lines 11-20 et seq). Further, Bodnar teaches 'transmitting the difference information to a second system' as (col. 8, lines 2-12). Bodnar teaches 'applying the difference information to generate change data for the second file' as (col. 8, lines 2-20). Finally, Bodnar teaches, 'updating the second file on the second system with the difference data' as datasets are collections of data. The purpose of synchronizing two, or more than two, datasets is to update them as necessary with data from one another so that they contain the same or equivalent data (generally, the latest data), at least in the portions of the datasets that the user has designated for synchronization (col. 6, lines 57-63 et seq).

As to claim 67, Bodnar teaches 'comparing data from the first file to a copy of a previous state of data from the first file' as (col. 4, lines 17-30 et seq).

As to claim 71, Bodnar teaches 'step of transmitting comprises coupling the first system and the second system to a network and transmitting said information from the first system to the second system via the network' as (col. 4, lines 15-33 et seq).

As to claim 72, Bodnar teaches 'the network is the Internet' as the system transform from an Internet Sidekick.RTM. cardfile for business contacts into a synchronization-system-internal representation (col. 8, lines 3-7).

As to claim 73, Bodnar teaches 'step of transmitting comprises coupling the first system and the second system to a server and transmitting said information from the first system to the server, and from the server to second system' as (col. 15-33 et seq)

As to claim 74, Bodnar teaches 'step of coupling includes coupling the first and second system to the server via a network' as (col. 18-30, Figs. 2-3A).

As to claim 75, Bodnar teaches 'the network is the Internet' as the system transform from an Internet Sidekick.RTM. cardfile for business contacts into a synchronization-system-internal representation (col. 8, lines 3-7).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar et al. ('Bodnar' hereinafter), US Patent 6,295,541 B1 in view of LaRue et al., (LaRue' hereinafter), US Patent 6,487,560 B1.

As to claim 61, Bodnar disclose a data synchronization system (Abstract, lines 1-3). Bodnar teaches 'a server' as synchronize a new user dataset, such as one in a server computer that stores user information (Abstract, lines 7-8). Further Bodnar teaches 'a first system having a plurality of data file types on the system' as in synchronizing two, or more than two, datasets, a correspondence is generally established between particular records across the datasets (col. 7, lines 13-15 et seq). Bodnar teaches 'a differencing synchronizer on the first system a first set of differencing data from the data files on the first system when the data files on the system are changed, outputting the differencing data to the server, and retrieving differencing data

from the server and applying it to selected data files on the first system' as that a user has two datasets in a first that resides on a desktop computer and a second that resides on a hand-held device. If the user later wishes to synchronize a third user dataset, such as one in a server computer that stores user information, the system has, in the GUD, all the information necessary for synchronizing the new dataset, regardless of whether any of the other datasets are then available. Therefore, correctly propagate information to any appropriate user dataset without having to "go back" to (i.e., connect to) the original user dataset from which that data originated. The system includes various "conflict" or "duplicate" resolution strategies that handle the increased complexities of allowing synchronization for an arbitrary number of datasets and including in the synchronization even data from datasets that are not available (col. 4, lines 18-33 et seq). Bodnar teaches 'at least one second system having a second plurality of data file types on the second system' as (Abstract, lines 1-10 et seq) Finally, Bodnar teaches 'a differencing synchronizer on the second system the differencing data from the data files on the second system when the data files on the system are changed, outputting the differencing data to the server, and retrieving the first set of differencing data from the server and applying it to selected data files on the second system' as one in a server computer that stores user information, the system has, in the GUD, all the information necessary for synchronizing the new dataset, regardless of whether any of the other datasets are then available. Therefore, correctly propagate information to any appropriate user dataset without having to "go back" to (i.e., connect to) the original user dataset from which that data originated. The system includes various "conflict" or

"duplicate" resolution strategies that handle the increased complexities of allowing synchronization for an arbitrary number of datasets and including in the synchronization even data from datasets that are not available (col. 4, lines 21-33 et seq). Although Bodnar discloses extracting set of difference data, which appear to be analogous for differencing in synchronization as explained in the present application. However, LaRue discloses an analogous system wherein extracting data from the data set as a synchronization of data (col. 9, lines 43-50 et seq). It would have obvious to one ordinary skill in the art of synchronizing data set, at the time of the present invention, to combine the teachings of the cited references because the extracting data set of LaRue's system would have provided Bodnar's system necessary infrastructure, which would allow the extracting data set from the synchronization data to differencing synchronizer, as explained in LaRue (col. 9, lines 43-50).

As to claim 62 Bodnar teaches 'the system are coupled to allow transfer of said difference data between systems' as (Figs. 2-3A)

As to claim 63, Bodnar teaches 'systems are coupled via the Internet' as the system transform from an Internet Sidekick.RTM. cardfile for business contacts into a synchronization-system-internal representation (col. 8, lines 3-7).

As to claim 64, Bodnar teaches 'a server coupled to each of said first and second systems to receive, store, and output said first set and said second set of differencing data' as as one in a server computer that stores user information, the system has, in the GUD, all the information necessary for synchronizing the new dataset, regardless of whether any of the other datasets are then available (col. 4, lines 21-27 et seq).

As to claim 65, Bodnar teaches 'first system is a server and said second system is a device capable of communicating with said server' as (Figs. 2-5A et seq)

10. Claims 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar et al. ('Bodnar' hereinafter), US Patent 6,295,541 B1 as applied to claims 66-67 and 71-75 in view of LaRue et al., (LaRue'), US Patent 6,487,560 B1.

As to claim 68, Bodnar teaches 'comparing step comprises data from said first file, converting said data to a universal file format, providing 'said copy of said data in said universal format, and comparing said data and said copy to provide difference data in said universal format' as (col. 25, lines 56-62). Although Bodnar discloses extracting set of difference data, which appear to be analogous for differencing in synchronization as explained in the present application. However, LaRue discloses an analogous system wherein extracting data from the data set as a synchronization of data (col. 9, lines 43-50 et seq). It would have obvious to one ordinary skill in the art of synchronizing data set, at the time of the present invention, to combine the teachings of the cited references because the extracting data set of LaRue's system would have provided Bodnar's system necessary infrastructure, which would allow the extracting data set from the synchronization data to differencing synchronizer, as explained in LaRue (col. 9, lines 43-50).

As to claim 69, Bodnar teaches 'constructing new file data for said second file in said universal data format' as (col. 4, lines 15-33). Although Bodnar discloses extracting set of difference data, which appear to be analogous for differencing in synchronization as explained in the present application. However, LaRue discloses an analogous

system wherein extracting data from the data set as a synchronization of data (col. 9, lines 43-50 et seq). It would have obvious to one ordinary skill in the art of synchronizing data set, at the time of the present invention, to combine the teachings of the cited references because the extracting data set of LaRue's system would have provided Bodnar's system necessary infrastructure, which would allow the extracting data set from the synchronization data to differencing synchronizer, as explained in LaRue (col. 9, lines 43-50).

As to claim 70, Bodnar teaches 'updating comprises translating said new file data into a format of said second file' as (col. 32, lines 43-47). Although Bodnar discloses extracting set of difference data, which appear to be analogous for differencing in synchronization as explained in the present application. However, LaRue discloses an analogous system wherein extracting data from the data set as a synchronization of data (col. 9, lines 43-50 et seq). It would have obvious to one ordinary skill in the art of synchronizing data set, at the time of the present invention, to combine the teachings of the cited references because the extracting data set of LaRue's system would have provided Bodnar's system necessary infrastructure, which would allow the extracting data set from the synchronization data to differencing synchronizer, as explained in LaRue (col. 9, lines 43-50).

#### ***Contact Information***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

a. US Patent No. 5,710,922, issued to Alley et al. on 05/20/98. The subject matter disclosed therein is pertinent to that of Claims 49, 61, and 66 (e.g. data sets, synchronization difference data sets, at least two computer systems, etc.).

b. US Patent No. 6,044,381, issued to Boothby et al. on 03/28/00. The subject matter disclosed therein is pertinent to that of Claims 49, 61, and 66 (e.g. data sets, synchronization difference data sets, at least two computer systems, etc.).

a. US Patent No. 6,275,831 B1, issued to Bodnar et al. on 08/14/01. The subject matter disclosed therein is pertinent to that of Claims 49, 61, and 66 (e.g. data sets, synchronization difference data sets, at least two computer systems, etc.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790 or TC 2100 customer service (703) 306-5631. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Application/Control Number: 09/491,675  
Art Unit: 2177

Page 15

Mohammad Ali

Patent Examiner

April 23, 2003

  
JEAN P. HOMERE  
PRIMARY EXAMINER